

PATENT**C. REMARKS**Status of the Claims

Claims 1-4, 6-11, 13-18, and 20-23 are currently present in the Application, and claims 1, 8, and 15 are independent claims. No claims have been added, amended, or cancelled in this Response.

Claim Rejections - 35 U.S.C. § 102(f)

Claims 1-4, 6-11, 13-18, and 20-23 stand rejected under 35 U.S.C. § 102(f) alleging that the Applicant did not invent the claimed subject matter. Applicant respectfully traverses the rejections.

Declaration of Mr. Van Hensbergen

In Applicant's previous response (18 May 2005), Applicant submitted a declaration pursuant to 37 C.F.R. § 132 detailing the fact that the alleged co-inventor, Mr. Papathanasiou was a student-employee working under the direction of the Applicant. As the Applicant declared in his declaration, the Applicant solely conceived of the claimed invention.

Declaration of Mr. Papathanasiou

Attached hereto is a Declaration under 37 C.F.R. § 132 by the alleged co-inventor, Mr. Papathanasiou. In the attached declaration, Mr. Papathanasiou admits that he did not conceive of the claimed invention. Pursuant to MPEP § 2137.01(II), a person must contribute to the conception of the invention in order to be an inventor. Specifically, § 2137.01(II) states:

The definition for inventorship can be simply stated: "The threshold question in determining inventorship is who conceived the invention. Unless a person contributes to the

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conception of the invention, he is not an inventor. . Insofar as defining an inventor is concerned, reduction to practice, per se, is irrelevant [except for simultaneous conception and reduction to practice, *Fiers v. Revel*, 984 F.2d 1164, 1168, 25 USPQ2d 1601, 1604-05 (Fed. Cir. 1993)]. One must contribute to the conception to be an inventor." *In re Hardee*, 223 USPQ 1122, 1123 (Comm'r Pat. 1984). See also >*Board of Education ex rel. Board of Trustees of Florida State Univ. v. American Bioscience Inc.*, 333 F.3d 1330, 1340, 67 USPQ2d 1252, 1259 (Fed. Cir. 2003) ("Invention requires conception." With regard to the inventorship of chemical compounds, an inventor must have a conception of the specific compounds being claimed. "[G]eneral knowledge regarding the anticipated biological properties of groups of complex chemical compounds is insufficient to confer inventorship status with respect to specifically claimed compounds.");< *Ex parte Smernoff*, 215 USPQ 545, 547 (Bd. App. 1982) ("one who suggests an idea of a result to be accomplished, rather than the means of accomplishing it, is not an coinventor"). See MPEP § 2138.04 - § 2138.05 for a discussion of what evidence is required to establish conception or reduction to practice.

Accordingly, Mr. Papathanasiou cannot be an inventor because he did not contribute to the conception of any of the claims set forth in Applicant's application. In light of the declarations provided by the Applicant and Mr. Papathanasiou, Applicant respectfully requests that the Examiner withdraw the rejection of Applicant's claims under 35 U.S.C. § 102(f), as it is amply clear that Applicant solely invented the claimed subject matter.

The Final Office Action did not reject any of Applicant's claims except for the § 102(f) rejections addressed above. Accordingly, each of Applicant's remaining claims is in a condition for allowance. Therefore, Applicant respectfully requests a Notice of Allowance of Applicant's remaining claims in the next Office Communication.

PATENT**Conclusion**

As a result of the foregoing, it is asserted by Applicant that the remaining claims in the Application are in condition for allowance, and Applicant respectfully requests an early allowance of such claims.

Applicant respectfully requests that the Examiner contact the Applicant's attorney listed below if the Examiner believes that such a discussion would be helpful in resolving any remaining questions or issues related to this Application.

Respectfully submitted,

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